

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <i>GP-304500 (1869.3043.001)</i>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number <i>10/786,980</i>	Filed <i>2/25/2004</i>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		First Named Inventor <i>HITAN S. KAMORAR</i>	
		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Art Unit <i>286.3</i></td> <td style="padding: 5px;">Examiner <i>JOHN H. LE</i></td> </tr> </table>	
Art Unit <i>286.3</i>	Examiner <i>JOHN H. LE</i>		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <i>56,041</i>			
Signature <i>[Signature]</i> Typed or printed name <i>MICHAEL C. ADAMS</i>		Telephone number <i>248.689.3500</i> Date <i>4/16/2007</i>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/786,980

Hitan S. Kamdar

Filed via EFS

METHOD AND SYSTEM FOR PROVIDING AUTOMATED
VEHICLE DIAGNOSTIC FUNCTION UTILIZING TELEMATICS UNIT

Filed: February 25, 2004

Group Art Unit: 2863

Examiner: John H. Le

Attorney Docket No. GP-304500-OST-ALS

PRE-APPEAL BRIEF CONFERENCE REQUEST FOR REVIEW

This request for a Pre-Appeal Brief Conference is being filed with a Notice of Appeal and is in response to a final office action, dated October 16, 2006 (hereafter referred to as the “Fourth Office Action.”) In that office action, claims 1 and 20 were rejected under 35 USC §112, second paragraph, claim 19 was rejected under 35 USC §101, and claims 1-5, 7-9 and 19-26 were rejected under 35 USC §103.

Rejection Under 35 USC §112, Second Paragraph –

In the Fourth Office Action, the Examiner rejected claims 1 and 20 under 35 USC §112, second paragraph, as being indefinite for having an insufficient antecedent basis for the term “analysis.” This rejection is traversed on the basis that the term “analysis,” as used in claims 1 and 20, does not require an antecedent basis. Claims 1 and 20 both state, “...such that the stored diagnostic data *is made available for analysis.*” This is the only occurrence of the term “analysis” in those claims, as it is simply introduced one time and is not referred to again. Thus, the term “analysis” in claims 1 and 20 is neither indefinite nor unclear, as explained in MPEP §2173.05(e).

Rejection Under 35 USC §101 –

Claim 19 stands rejected under 35 USC §101 for being directed to non-statutory subject matter. More specifically, the Examiner reasons that claim 19 is directed to an abstract idea, but not a practical application of an abstract idea because it does not: 1) result in a physical transformation, or 2) produce a tangible result (Examiner concedes that claim 19 appears to be both useful and concrete¹). The Applicant traverses this rejection because claim 19, which is drafted in means-plus-function format, is specifically directed to *a system having structure* and therefore is not an abstract idea producing no tangible results.

Claim 19 is presented in means-plus-function format that conforms with the requirements of §112, sixth paragraph, and thus reads on structures disclosed in the specification and equivalents thereof. Moreover, each of the four means elements recited in claim 19 has supporting structure in the present application. Referring now to *In re Alappat*², the Federal Circuit stated,

Although many, or arguably even all, of the means elements recited in claim 15 represent circuitry elements that perform mathematical calculations, which is essentially true of all digital electrical circuits, the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. *This is not a disembodied mathematical concept which may be characterized as an “abstract idea,” but rather a specific machine to produce a useful, concrete, and tangible result.* (Emphasis added.)

Like the means-plus-function claim in *Alappat*, claim 19 is not merely a process claim in the guise of an apparatus claim, rather it covers a system; namely, “[a] system for providing automated vehicle diagnostic functions.” Accordingly, it is the Applicant’s position that claim 19 calls for a system having structural components and is therefore patentable subject matter under §101. The Applicant respectfully asks that this rejection be withdrawn.

Rejection Under 35 USC §103(a) –

Claims 1 and 19 stand rejected under 35 USC §103(a) as being unpatentable over Marko et al. (US Patent No. 6,745,151) in view of Sonnenrein (US Patent Application Publication No.

¹ Office Action dated October 16, 2006; top of page 3

² *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994)

2005/0154500) and Shirane (US Patent No. 5,491,631). The Applicant respectfully traverses this rejection for at least the reason that Shirane fails to disclose or even suggest, “configuring a primary diagnostic script for a telematics equipped mobile vehicle wherein the primary diagnostic script *recreates known problem sequences* when executed.”

According to the Examiner³, Col. 10, line 50 - Col. 11, line 14 of the Shirane patent (hereafter “the Shirane passage”) *inherently discloses* a primary diagnostic script that recreates known problem sequences, as called for in claims 1 and 19. The Applicant respectfully disagrees with this rejection for several reasons. First, even under the broadest reasonable interpretation of the claims, the Examiner has *failed to establish a prima-facie case* that the Shirane passage *inherently discloses* a primary diagnostic script that recreates known problem sequences, as recited in claims 1 and 19.

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference.... The mere fact that a certain thing *may result from a given set of circumstances* is *not sufficient*.”⁴ (Emphasis added.)

The Examiner has not offered any reasoning or support for the contention that the claimed feature is necessarily present in the Shirane passage. When asked during a telephone interview⁵ what specific part of the Shirane passage supports his finding of an inherent disclosure, the Examiner further identified Col. 10, lines 58-64 as the source. Analysis of that section, however, reveals no explanation as to why it would be *necessary* to have a primary diagnostic script that recreates known problem sequences. Thus, the Examiner has failed to establish a prima-facie case that the Shirane passage inherently discloses a primary diagnostic script that recreates known problem sequences, as claimed.

Second, not only does the Shirane passage fail to inherently disclose a primary diagnostic script that recreates known problem sequences, as proffered by the Examiner; *it does not even appear to be capable of performing such a feature*. Claims 1 and 19 call for a primary diagnostic script that recreates known problem sequences when executed, which in turn can cause known undesirable vehicle system operation in similar vehicles. Put differently, the claimed method *purposely causes some type of undesirable vehicle system operation* so that the results can be observed and analyzed. The Shirane passage relied upon by the Examiner describes a process that is nothing like this.

³ Office Action dated April 13, 2006; page 7; Interview Summary dated March 29, 2007; page 3

⁴ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1 (Fed. Cir. 1999)

⁵ Interview Summary dated March 29, 2007

According to Shirane, the process selects and verifies a correct vehicle identification number (VIN), and then uses that VIN for selecting a particular fault diagnostic program. Assuming that the VIN has been correctly entered, it is used as a key to select a particular fault diagnostic program from fault diagnostic program storage means 36. Once the fault diagnostic program is selected and performed, a fault diagnosis and analysis can be made so that information such as the model, destination, production year, and production factory of the defective vehicle can be accurately gathered. At best, Shirane discloses a program for detecting and analyzing a fault that has already occurred, but does not teach configuring a primary diagnostic script to *purposely recreate a known problem sequence*.

Claim 20 also stands rejected under 35 USC §103(a) as being unpatentable over Marko in view of Sonnenrein and Shirane. This rejection is traversed on the grounds that Marko does not show determining a primary diagnostic script that "...includes a *plurality of diagnostics scripts* that are determined *based on diagnostic options*," as recited in claim 20. Turning now to the present application, an exemplary embodiment of this feature is provided:

In one example, the advisor identifies diagnostic routines by presenting high level questions to the client/technician and filters the answers to obtain one or more diagnostic scripts for mobile vehicle 210. The diagnostic scripts are combined to produce a primary diagnostic script and provided to mobile vehicle 210 for execution.⁶

A single primary diagnostic script can include a number of diagnostic scripts where each diagnostic script is determined based on diagnostic options, such as high level questions posed to a client or technician. Once the primary diagnostic script has been assembled together with its sub-scripts, it can be provided to the mobile vehicle.

Col. 8, lines 26-30 in Marko (hereafter the 'first Marko passage') was identified by the Examiner in the Fourth Office Action and simply states that scripted algorithms and histogram reference patterns can be updated with new or modified versions. There is nothing in the first Marko passage that states that *a single primary diagnostic script can have a plurality of diagnostic scripts*, as called for in claim 20. Likewise, Col. 7, line 66 – Col. 8, line 2 ('second Marko passage') fails to disclose determining a plurality of scripts *on the basis of diagnostic*

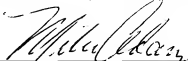
⁶ US Application No. 10/786,980; page 14, first full paragraph

options, as taught in the present application and recited in claim 20. In claim 20, it is clear that the diagnostic options are used in the determination of the diagnostic scripts, which in turn is used in the determination of the primary diagnostic script. The second Marko passage makes no suggestion of utilizing any types of diagnostic options in the creation of a primary diagnostic script. It simply states that data signals collected by the diagnostic module can be used as input when executing the scripted algorithms; not when creating them.

For at least the foregoing reasons, the Applicant respectfully asks for reconsideration and withdraw of the outstanding rejections.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.

A handwritten signature in black ink, appearing to read "Michael C. Adams", is written over a horizontal line.

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Date: April 16, 2007
JDS/dim